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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,127	03/23/2004	Akira Hirose	119191	2111
25944	7590	07/05/2007	EXAMINER	
OLIFF & BERRIDGE, PLC			VO, TED T	
P.O. BOX 19928			ART UNIT	
ALEXANDRIA, VA 22320			PAPER NUMBER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/806,127

Applicant(s)

HIROSE ET AL.

Examiner

Ted T. Vo

Art Unit

2191

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/23/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/23/04, 3/16/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response to the communications filed on 03/23/2003.  
Claims 1-19 are pending in the application.

#### ***Information Disclosure Statement***

2. The submissions of information disclosure statements have been acknowledged.  
A content of information submitted on 3/16/2006 is in foreign language. The submission provides no explanation. According to 37 CFR 1.98(a)(3)(i)

A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from applicant's specification or incorporated therein.

The content of information that causes to be listed does not meet the requirement under 1.98(a). It will not be considered and will result in being strikethrough.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-19: With regards to the recitation in the claims' independents, the recitations are ambiguous. According to the assertion of the specification in the "Back Ground of the Invention", the claim recites that it forms an "input part" that inputs an "instruction form" (Claim: "***an instruction form input part***" that inputs "***an instruction form***" to indicate execution of a process) to consolidate an execution process of various steps (such as process 1, 2, 3, in the specification). Upon the completion of the execution, a delete part will delete the "instruction form" (claim: ***a deletion part that deletes "the instruction form"***). Both the specification and the claims fail to indicate a clear manner of the language used as "instruction form". This is ambiguity of the claims in term of deletion because if the "instruction form" is concrete, containable, when it is deleted, how can it be appeared for a deletion? What is this "instruction form"? How does it look like? It is uncertain what the "instruction form" is. To expedite the examination, examiner interprets "instruction form" as the input text in an input form.

Claims 1-19 are based on the recitation (as indicated above), which is unclear and has the whole scope of the claims ambiguous, the claims 1-19 are indefinite.

#### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. The claims 1-18 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.

As per Claims 1-4: The claims recite an instruction form execution apparatus but the recitation appears as a data structure in which it has a list of descriptive materials, where: there is no limitation

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connecting the apparatus to execution elements, or the claims' elements impart functionality. This type of the claims fails to be statutory claim. The claims are list per se, data structure per se.

As per Claims 5-7: The claims recite a data structure and/or list per se as in the claims 1-4.

As per Claims 8-10: The claims recite an instruction form management system but the recitation appears as a software per se data structure in which it has a list of descriptive materials, where: there is no limitation connecting the system to execution elements. This type of the claims fails to be statutory claim. The claims are list per se, software per se.

As per Claims 11-13, and 14-16: The claims recite a program and/or list per se as in the claims 8-10.

As per Claims 17-18: The claims recite software per se, an instruction form having an execution instruction. The claims are software per se.

#### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-19 are rejected under 35 U.S.C. 102(a) as being anticipated by Watters et al, "PDA Access to Internet Content: Focus on Forms", IEEE, Proceedings of the 36th Annual Hawaii International Conference, pages 1-9, 1-2003.

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Given the broadest reasonable interpretation of followed claims in light of the specification.

As per Claim 1: Watters discloses a combo of forms formatted in an PDA from an original form, using XML, it executes only once to transmit all input data to a device; the teaching discloses,

***An instruction form execution apparatus*** (e.g. Figure 3, p. 3) ***comprising: an instruction form input part*** (Figure 3: forms and text areas appeared as rectangular boxes in the forms) ***that inputs an instruction form*** (the texts input by users) ***to indicate execution of a process*** (the structure tree, where the users program in order to form a desirable task); ***an execution part that executes the process indicated in the instruction form*** (the submit button such as seen in Figures 4-5: "submit this information"); ***and a deletion part that deletes the instruction form when the execution part completes the execution of the process indicated in the instruction form*** (The submit button acting like and execution part because after submitting the input data ("instruction form"), the input type "submit" will indicate the blank area after data submitted; if with an input type that data has not gone, then reset button meets the claim limitation, "Reset this form").

As per Claim 2: Watters discloses, ***The instruction form execution apparatus according to claim 1, wherein the instruction form indicates execution of the process in plural instruction form execution apparatuses*** (e.g. Figure 4), ***and the deletion part deletes the instruction form when the execution of the process is completed in the plural instruction form execution apparatuses*** (As discussed in the claim 1 for deletion, the form has transmitted, gone, compliant to the web languages such as XML/HTML (see p. 5, left col. completed form is sent used in a PDA device; i.e. to proceed again, the user has to retrieve a new form).

As per Claim 3: Watters discloses, ***The instruction form execution apparatus according to claim 1, further comprising an instruction form determination part that determines whether or not the instruction form includes information to delete the instruction form when the execution part completes the execution of the instruction indicated in the instruction form, wherein the deletion part deletes the instruction form if the instruction form includes the information to delete the instruction form*** (This claim is inherent from the transmission of an execution such as "click" on FORM button.

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As per Claim 4: Watters discloses, ***The instruction form execution apparatus according to claim 3, wherein the information that indicates deletion of the instruction form indicates that the instruction form is executed only once*** (a submit that causes data transformed to the other device, the form will be blank: this seen as in the sending the text of an email, the act of sending causes only once).  
As per Claims 5-7, 8-10, 11-13, 14-16, 17-18, and 19: Watters discloses the claimed limitations because the claims have the functionality in the same manner as the functionality as recited in Claims 1-4.

### ***Conclusion***


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ted T. Vo whose telephone number is (571) 272-3706. The examiner can normally be reached on 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y. Zhen can be reached on (571) 272-3708.

The facsimile number for the organization where this application or proceeding is assigned is the Central Facsimile number **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTV  
June 22, 2007

  
TED VO  
PRIMARY EXAMINER